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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,207	12/07/2001	Vincent G. Bovio	1826-AY	1385

7590

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EXAMINER

PHAN, HAU VAN

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,207

Applicant(s)

BOVIO, VINCENT G.

Examiner

Hau V Phan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18, 21, 22 and 24-33 is/are rejected.
- 7) ☒ Claim(s) 19, 20 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 and 34, drawn to a heat shield for a vibration insulator, classified in class 60, subclass 299.
 - II. Claims 12-33, drawn to a heat shield and a vibration insulator for a vehicle exhaust system, classified in class 180, subclass 309.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as vehicle exhaust system comprising an insulator and a heat shield set forth in the combination claims 12-33 for its patentability. The subcombination has separate utility such as heat shield could be used on combustion engine and motor.
3. During a telephone conversation with Mr. Joseph Sebolt on 4/1/2003 a provisional election was made without traverse to prosecute the invention of invention II, claims 12-33. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 1-11 and 34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 12, 21-22, 26 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Norito et al. (JP 02-092727).**

Norito et al. in figures 1-4 disclose a vibration-isolating device for a vehicle exhaust system comprising an insulator (5) having an outer surface, a front surface and a rear surface. Norito et al. also disclose a heat shield (1) having a cup shaped body defining a chamber. The insulator substantially disposed within the chamber and the heat shield adapted to insulate the insulator from an external heat source.

Regarding claims 21 and 33, Norito et al. disclose the heat shield and insulator having an air space between them (figure 5).

Regarding claim 22, Norito et al. disclose the insulator including protuberances and valleys between the protuberances. The body of heat shield includes sidewalls and the air spaces are formed between the valleys and the sidewalls (figures 4-5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 13-18, 24-25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norito et al.**

Regarding claims 13-16 and 27-30, Norito et al. disclose a heat shield (1), which is made from a rigid material, but fail to show the heat shield made from a flexible, heat-resistant material, an elastomer, a silicone elastomer from a group ASTM D200, classification GE, FC, FE and FK. It would be a matter related to the choice of ornamentation producing no mechanical effect and take advantage of that select material such as heat resistant, last long and flexible or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claims 17-18 and 31-32, Norito et al. disclose an insulator (5), which is made from a rubber, but fail to show the insulator, which is made from fluorolastomer and ethylene acrylic. It would be a matter related to the choice of ornamentation producing no mechanical effect and take advantage of that select material such as heat resistant, last long and flexible or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claim 24, Norito et al. disclose the heat shield in a U-shaped section, but fail to show the shaped of the heat shield like a diamond with rounded corners. It would have been an obvious matter of design choice to make the heat shield to whatever relative shape were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. *In re Reese*, 129 USPQ 402.

Regarding claim 25, Norito et al. disclose the heat shield including straight sidewalls, which is extended between the rounded corners (figure 5).

Allowable Subject Matter

8. Claims 19-20 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown discloses an exhaust system hanger, Leventhal discloses suspension means for automobile mufflers, Heath discloses a heat shield for exhaust system, Hubbell, III discloses an exhaust system mounting, Masuda discloses a device for suspending an exhaust pipe in vehicles, Shimada et al. disclose a mounting for a heat producing element of an automobile, Reid discloses a reinforced molded rubber

muffler hanger, Donovan, Jr. et al. disclose a compact universal hanger for tailpipes and the like, Schad discloses a suspension element for the exhaust system, Bruine et al. disclose a universal bracket assembly, Fujita discloses a rubber vibration isolator for muffler and Karner et al. disclose an exhaust pipe hanger assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on 703-308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

HP *HP*
April 4, 2003

Brian L. Johnson
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4/4/03